REMARKS

This application has been carefully reviewed in light of the current **SEVENTH** Office Action on the merits. Applicant respectfully objects to the seemingly endless stream of Office Actions in the present application, which has subjected the undersigned client to needless delay and expense, and has jeopardized Applicant's scope of patent protection needlessly. Applicant respectfully requests reconsideration in view of the following:

Interview Request

In view of the protracted prosecution in this case, including one appeal which was not allowed to go to the Board, Applicant respectfully requests the courtesy of a telephone interview to resolve any remaining matters, should the Examiner feel that the amendments and arguments presented below do not place the application in condition for allowance.

Regarding the Nathan Reference and Applicant's Invention in General

The Nathan reference has been reviewed in detail in response to this Office Action. Nathan teaches a "jukebox" such as that "usually placed in a leisure area such as a bar." (Col. 1, lines 11-13) Such jukebox is rented by a bar **manager** from an **operator** in order to provide entertainment for his **customers or users**. The Nathan reference does indeed appear to have an element 35 and associated credit reserve that appear to operate in a manner somewhat similar to that of Applicant's "playback credit bank". However, a number of fundamental differences need to be considered in determining patentability, and in particular obviousness, of Applicant's claims.

Applicant's device is intended for embodiment in a home or auto audio system or a personal or portable audio systems (such as a WalkMan® brand personal audio device). Such devices are quite far removed from the large stationary jukeboxes of the type commonly found in bars. One must consider what a bar's jukebox such as that of Nathan honestly suggests to one of ordinary skill in the art when considering patentability of Applicant's invention. One must even consider whether or not one of ordinary skill in the art most relevant to Applicant's invention would even consider a bar jukebox to be

analogous art. A significant case can be made that it is not analogous, but perhaps more importantly, it is submitted that one should step back and view a bar jukebox for what it truly is and what it teaches in the field of Applicant's endeavor.

While the jukebox scenario does indeed have certain pay-per-play attributes, one must carefully consider the facts and the environment. Jukeboxes have been prevalent in bars and clubs for many decades and have operated on a pay-per-play paradigm in a manner such as that of Nathan or using earlier mechanical mechanism. For an even longer period of time, personal entertainment devices such as home or personal audio players have been used by consumers for personal entertainment by playback of personally owned content (records, CDs, etc.). However, with the decades of evolution and coexistence of both types of products, the paradigm of pay-per-play has never crossed over from the jukebox world to the personal entertainment devices of the type conventionally owned by individuals and families for personal or home or auto entertainment. Even with downloadable music from companies such as Sony Music and Apple Computer having recently become a reality, the pay-per-play paradigm is not yet used. Thus, even after decades of evolution and revolution in both the technologies of personal/home/auto entertainment and jukeboxes, the pay-per-play paradigm remains a phenomenon reserved for jukeboxes, with copyright owners even being paid based on plays of the content on the jukebox.

Hence, the user of home or personal or auto entertainment devices is faced with no choice but to purchase full rights to an item of content. Copyright owners are paid based upon the sale of the full rights to the item of content. If the user quickly grows tired of the content, or finds that after purchase of an album of content, there are only a few selections of interest, the investment is the same as if the content were played 24 hours per day. Accordingly, with Applicant's claimed pay-per-play paradigm for personal/home/auto entertainment, the user pays only for the content actually used. It must be carefully considered that the coexistence of pay-per-play for jukeboxes and full payment for content in a home or personal environment for many decades has not led to any crossover. This

leads to the clear conclusion that use of pay-per-play outside the jukebox world is not obvious.

These distinctions notwithstanding, certain of the claims appear to be inadvertently literally readable upon a device such as Nathan. Hence, certain amendments have been made in an attempt to clearly distinguish over the references. It is Applicant's intent that such distinctions be clear and render the claims patentable, but should the Examiner feel that other or additional amendments are needed, the undersigned earnestly solicits such comments during a telephone interview in order to advance this case to issue at the earliest possible date.

The Rejections Under 35 U.S.C. §102

Claims 1-8, 10, 18, 19, 25-28 and 32-41 were rejected as anticipated by Nathan.

Regarding claims 1-8 and 10, 34, 35 and 41, independent claim 1 and 34 have been amended to require that at least one of the memory containing the content and the playback credit bank be "user removable". Additionally, claim 1 has been amended to require that the player reads content from the memory and the player incorporates means to install playback credits. Claim 8 has been rewritten to require that both the memory containing content and the playback credit bank reside on the same storage device.

There is no teaching or suggestion in Nathan of either a user removable memory or a user removable credit bank. In fact, the very nature of the jukebox type device of Nathan directly and obviously teaches against such limitations since the device is a "jukebox" that is "usually placed in a leisure area such as a bar" (Col. 1, lines 11-13) where in effect, the user rents music from the bar manager who in turn rents the jukebox from the operator. Such music is either resident on the jukebox or downloaded from a server. Neither a user removable memory containing the content nor a user removable playback credit bank is either taught or suggested by such a jukebox, and is wholly inconsistent therewith.

Moreover, a user removable playback credit bank as taught by Applicant would appear to be contrary to the normal operation of a bar jukebox since the bar manager

would have no way to retrieve the funds associated with playback if the credit bank were removable by the user. Similarly, there is no suggestion in Nathan of a user being able to play his own content from a user removable memory on the jukebox - again a direct contradiction of the teachings of Nathan. Accordingly, there is no anticipation, nor is there a suggestion that such a device could be or should be modified to meet the claim limitations as amended, since to do so would obviously prevent a jukebox from providing a profit to either the operator or the manager. Thus, as amended, these claims are neither anticipated nor obviated by Nathan alone or in combination with any other reference. Reconsideration is respectfully requested.

Regarding claims 18 and 19, 25-28 and 32-33 these claims or their base claims have also been amended to require that the content bearing medium be "user removable." Again there is no teaching or suggestion of such limitation in the Nathan reference of record, and the nature of such a "jukebox" suggests against such a limitation. Reconsideration and allowance is respectfully requested.

Regarding dependent claims 2-4, 21, 36 and 37, in view of their dependency of the amended base claims, it is submitted that these claims are also allowable. Regarding the assertion that *"the money accepting interface can be considered a kiosk"* - with all due respect - this is an assertion that is totally devoid of any basis. Nathan contains absolutely no teaching that could reasonably lead one to interpret a money accepting interface as a kiosk. Moreover, such an assertion is in clear contradiction to the plain dictionary meaning of the word "kiosk" ("1. in Turkey and Pursia, a summerhouse or pavilion of open construction" - "2. a somewhat similar small structure open at one or more sides, used as a newsstand, bandstand, covering to the entrance of a subway, etc." - Webster's New Universal Unabridged Dictionary). Reconsideration and allowance are respectfully requested.

Regarding claims 5-7 and 38-40. Applicant respectfully traverses again on the grounds that these claims now depend from allowable base claims. Additionally, regarding claims 7 and 40, the cited passage has been examined and Applicant finds no teaching or suggestion of a reminder to purchase new credits. Moreover, the cited passage only teaches that the user is advised of the right to make a free musical selection, and then apparently only upon the user winning an advertisement based game. Reconsideration is respectfully requested.

The Rejections Under 35 U.S.C. §103

Regarding the rejection to claims 9, 22, 29 and 42, Applicant respectfully traverses as follows:

MPEP 2143.01 requires that there must be some motivation in the art to make the combination proposed. Paragraph 4 of the Office Action provides no hint as to why one of ordinary skill in the art would be motivated to make the proposed combination of Nathan and Buchheim of record. In the absence of the Examiner pointing out where one can find such a motivation, *prima facie* obviousness cannot be established. It is the Examiner's obligation to establish such motivation in order to establish *prima facie* obviousness. Additionally, MPEP 2143.01 notes that the mere fact that references can be combined and even that such combination is within the skill of one of ordinary skill in the art is inadequate in the absence of a suggestion or motivation in the art.

In making this rejection the Examiner proposes combining Buchheim's teaching of use of various removable memory devices with the teachings of Nathan. It is respectfully submitted as noted above, that the claims now call for a removable memory device or content bearing medium or similar language. Accordingly, combining the teachings of Buchheim with Nathan would simply allow a user to remove certain of the content from the jukebox of Nathan. Clearly this is contrary to the teachings of Nathan. Nathan makes no suggestion of need for expansion of memory capacity or portability of it's contents, and certainly contains no suggestion that a user should be able to remove credits or content from his jukebox.

The undersigned further reiterates that above explained historical dichotomy between the pay-per-play paradigm for jukeboxes and other content players and submits that there is no teaching in the cited references that would lead to a breakdown in this dichotomy. Reconsideration and allowance is requested.

Regarding the rejection to claims 11, 12, 14, 16 and 44 based upon the combination of Curtin and Nathan, Applicant respectfully traverses as follows:

Applicant first of all wishes to focus on the Office Action's statement in reference to Curtin's silence with regard to payment for downloaded content, that *"although Curtin was silent, it is the Examiner's view that such fee paying means perhaps are incorporated in Curtin. " (Emphasis added)* The undersigned respectfully but strongly objects to use of pure speculation in denial of Applicant protection of his invention. The law clearly requires that the Applicant is entitled to a patent unless the Examiner can establish *prima facie* unpatentability. In this case, the Examiner is openly engaging in pure speculation and using that as cause to deny Applicant of patent protection. This is inappropriate and, frankly, quite shocking - especially in the context of a seventh office action (which is shocking enough in and of itself!).

Applicant additionally again submits that the Examiner has provided no explanation of a motivation for making the combination of Curtin with Nathan. Curtin has no teaching or suggestion of any payment mechanism, and none of the cited art would motivate one of ordinary skill to make the proposed combination for all the reasons discussed above. There is no motivation to incorporate Nathan's jukebox pay-per-play paradigm into Curtin.

The Examiner appears to use the need to pay Copyright royalties as some form of motivation to make the combination, but if this is the sole motivation, it simply does not hold water. Processes have already been established for payment of Copyright royalties to Copyright owners for downloaded music without use of a pay-per-play scenario. Thus, the Copyright owners interests have been accounted for (there is no problem for which the

Examiner submits the solution to be obvious) and the undersigned finds no motivation in the cited art to cross the boundaries to pay-per-play.

The undersigned further reiterates that above explained historical dichotomy between the pay-per-play paradigm for jukeboxes and other content players and submits that there is no teaching in the cited references that would lead to a breakdown in this dichotomy. Reconsideration and allowance is requested.

Regarding the rejection to claims 15, 23, 24, 30, 31 and 43 based upon the combination of Curtin in view of Nathan and Peters, Applicant respectfully traverses as follows:

Applicant reiterates all of the above discussion as to why there is no viable motivation to combine the teachings of Curtin and Nathan. Applicant's review of Peters indicates that it contributes little more to the present discussion than to illustrate a vending machine that can accept credit cards. Applicant finds no viable explanation in the Office Action as to why one of ordinary skill in the art would look to a vending machine when seeking to provide an improved personal or home or automobile content player. While the vending machine of Peters does vend recorded content, Peters is clearly non-analogous art that is outside Applicant's field of endeavor.

Moreover, Applicant finds no motivation in the art to make the proposed combination, and none has been provided by the Office Action.

Concluding Remarks

The claims have been amended to assure that there is no possibility of reading on the Nathan Jukebox. Applicant respectfully requests entry of these amendments to place the application in better condition for appeal.

Claim 45 was again indicated allowable, and this indication is appreciated by the undersigned.

All remaining claims are now believed to be in condition for allowance and in better condition for appeal. Reconsideration and allowance of all remaining claims are respectfully requested.

Respectfully submitted,

Jerry A. Miller, Reg. No. 30,779

Dated: 2/23/2005

Please Send Correspondence to:
Miller Patent Services
2500 Dockery Lane
Raleigh, NC 27606
Phone: (919) 816-9981
Fax: (919) 816-9982
Customer Number 24337